

Appl. No. 09/997,423  
Reply to Office Action of March 17, 2004

102729-12

### REMARKS

Claims 1-34 are pending in the application. Claims 21-34 have been withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a non-elected invention. Claims 1-20 have been rejected.

Claims 1 and 16 have been amended. Support for the amendments can be found throughout the specification as originally filed. Specifically, support for an increase in FKBP54 expression being indicative of prostate cancer can be found, for example, at page 9, lines 10-11 and page 93, lines 9-11. No new matter has been added by the proposed amendments. Amendment of the claims should in no way be construed as an acquiescence to any of the Examiner's rejections and was done solely to more particularly point out and distinctly claim the invention to expedite the prosecution of the application. Applicant reserves the right to pursue the claims as originally filed in this or a separate application(s).

#### *Claim Rejection Under 35 U.S.C. § 112, First Paragraph*

Claims 1-20 are rejected under 35 U.S.C. 112, first paragraph. Applicants respectfully traverse this rejection. In light of the following amendments and remarks, Applicants respectfully request that this rejection be withdrawn.

The Examiner states that "while the teachings of the specification are sufficient to enable one of skill in the art to practice methods of assessing whether a human subject has prostate cancer and methods for monitoring the progression of prostate cancer in a human subject in which increased levels of FKBP54 expression products are detected, it would require undue experimentation to use applicant's invention as claimed." While the Examiner has conceded that "the prior art is silent with respect to any association between a decrease in FKBP54 expression and prostate cancer," Applicants have amended the claims in order to expedite prosecution. Amended claims 1 and 16 recite that an "increase" in the expression of the FBP54 marker is an indication that the human subject is afflicted with prostate cancer or is an indication of prostate cancer progression, respectively. Accordingly, the Examiner is respectfully requested to withdraw this rejection.

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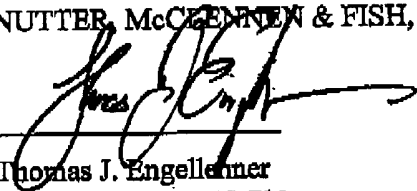
### CONCLUSION

In summary, the above-identified patent application has been amended and reconsideration is respectfully requested for all the reasons set forth above. In the event that the amendments and remarks are not deemed to overcome the grounds for rejection, the Examiner is kindly requested to telephone the undersigned representative to discuss any remaining issues.

Respectfully submitted,

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